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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,851	04/07/2006	Wim Meutermans	MJW-5066-6	9185

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EXAMINER	
CRANE, LAWRENCE E	
ART UNIT	PAPER NUMBER
1623	
MAIL DATE	DELIVERY MODE
07/08/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,851	MEUTERMANS ET AL.	
	Examiner	Art Unit	
	Lawrence E. Crane	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 16, 2010 (RCE & Amendment)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The Abstract of the Disclosure is objected to because is does not meet the requirement of the MPEP for US application. Correction is required. See MPEP §608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplifications of a species could be illustrative of members of the class. For processes, the type of reaction, reagents and process conditions should be stated, and generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet. The previous revision fails to include the instant claimed subject matter.

Claims **1-42** have been newly cancelled, no claims have been amended, the disclosure has not been amended, the Abstract has not been further amended, and new claims **43-61** have been added as per the amendment and Request for Continued Examination filed June 16, 2010. No additional or supplemental Information Disclosure Statements (IDSs) have been filed as of the date of this Office action.

Claims **43-61** remain in the case.

Note to applicant: when a rejection refers to a claim **X** at line y, the line number "y" is determined from the claim as previously submitted by applicant in the most recent response including ~~lines deleted by line through~~.

35 U.S.C. §101 reads as follows:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title."

Claim **61** is rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. §101. See

for example *Ex parte Dunki,* 153 USPQ 678 (Bd. App. ,1967) and *Clinical Products, Ltd. v. Brenner,* 255 F. Supp. 131, 149, 149 USPQ 475 (D.D.C. 1966).

In claim **61** at line 2, the term "to use" is in need of replacement with alternative terminology that is not derived from the verb "use."

Applicant's arguments with respect to claims **1-42** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments wherein a different subject matter has been claimed.

Claims **44, 60 and 61** are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim **44** the Markush group beginning at line 2 is populated with substituent groups and also with terms that refer to generic classes of compounds; e.g. "aminoalkyl" (" R-NH- " or " H_2N-R- "?), "aminodialkyl" (" RR'-N- " or " H_2N-RR'- "?), "aminotrialkyl" (did applicant intend trialkylammonium; e.g. " RR'R"N^+- " ?), "imine" (" -CH=NH " or " CH_2=N- " ?: both are chemically reactive/unstable: what H-replacing "substituents" are optionally present?), and "carbonyl" (implies claiming a radical because of a missing substituent definition). In addition there are several terms that include the terms "hetero" and "thio" impling thereby a heterocyclic chain or ring, but in each case the size of the substituent (C_1-$C_?$) and the identity and number of hetero atoms and/or sulfur heteroatoms or their locations have not been specified with adequate particularity.

Applicant is respectfully requested to rename all compound names as substituent names, make other amendments, or delete as appropriate.

Applicant's arguments with respect to claims **1-42** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments wherein a different subject matter has been claimed.

Claims **60 and 61** are improperly dependent because the subject matters being claimed therein (method of treatment limitations are implied) fail to further limit the subject matter of method of testing claim **43**.

Applicant's arguments with respect to claims **1-42** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments wherein a different subject matter has been claimed.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam,* 686 F. 2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi,* 759 F.2d 887, 225 USPQ 645 (Fed. Cir 1985); and *In re Goodman,* 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. §1.78(d).

Effective January 1, 1994, a registered attorney or agent or record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. §3.73(b).

Claims **43-61** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims ***1-20*** of copending Application No. **12/063,920**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method of testing claims are directed to substantially overlapping subject matter when compared with the method of testing claims in the **'920** application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments with respect to claims **1-42** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments wherein a different subject matter has been claimed.

Claims **43-61** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims ***22-25*** of copending Application No. **12/184,473**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method of testing claims are directed to substantially overlapping subject matter when compared with the method of testing claims in the **'473** application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments with respect to claims **1-42** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments wherein a different subject matter has been claimed.

Claims **43-61** of this application conflict with claims ***1-20*** of copending Application No. **12/063,920** and claims ***22-25*** of copending Application No. **12/184,473**. 37 C.F.R. §1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP §822.

No claims are allowed.

Papers related to this application may be submitted to Group 1600 via facsimile transmission (FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone number to FAX (unofficially) directly to Examiner's computer is 571-273-0651. The telephone number for sending an Official FAX to the PTO is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **571-272-0651**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. S. Anna Jiang, can be reached at **571-272-0627**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is **571-272-1600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status Information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see < http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

LECrane:lec
07/04/2010

/Lawrence E. Crane/

Primary Examiner, Art Unit 1623

L. E. Crane
Primary Patent Examiner
Technology Center 1600